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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of : Franciscus C. Caris et al.
Serial No. : 09/653,784
Filed : September 1, 2000
Atty. Docket : US000220
Group Art Unit : 2142
Examiner : Beatriz Prieto
Conf. No. : 5607

Mail Stop Appeal Brief - Patents
Commissioner for Patents
Alexandria, VA 22313

APPEAL BRIEF

Sir:

Enclosed is an Appeal Brief in the above-identified patent application. Please charge the fee of \$500.00 to Deposit Account No. 14-1270. Any additional fees associated with this application should be charged to Deposit Account No. 14-1270.

Respectfully submitted,

By Larry Silencione, Reg. No. 40,352
for Yuri Kateshov, Reg. No. 34,466
914-723-6802

May 29, 2006
06/13/2006 JBA/LINAR 00000095 141270 09653784
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APPEAL BRIEF

I. REAL PARTY IN INTEREST

The real party in interest is Philips Electronics North America Corporation, the assignee of record.

II. RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any pending appeals, judicial proceedings, or interferences which may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-3, 7-12, 14-16 and 19-25 are rejected.

IV. STATUS OF AMENDMENTS

An after-final amendment under 37 CFR 1.116 was filed on January 23, 2006 in response to the Final Office Action. The after-final amendment was entered into the record, pursuant to the Advisory Action of February 15, 2006. According to the Advisory Action, the objection to claims 2, 3 and 7 was withdrawn, but the rejection of claims 1-3, 7-12, 14-16 and 19-25 was maintained.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention, as recited in independent claim 1, is related to a method of enabling a particular user to program the particular user's remote control device for use with the

particular user's consumer electronics equipment (page 2, lines 19-20 of the specification). A network connectable appliance is connected to a dedicated server on the network in response to the particular user controlling the particular user's remote control device (page 2, lines 20-22). By the dedicated server via the network connectable appliance, alphanumeric information is requested from the particular user, corresponding to the particular user's consumer electronics equipment, wherein said dedicated server request is made to said network connectable appliance responsive to said connection above (page 2, lines 26-28). From the particular user to the dedicated server, via the network connectable appliance, the requested alphanumeric information is supplied, corresponding to the particular user's consumer electronics equipment (page 2, lines 28-29). A query is performed, at the dedicated server, based on the alphanumeric information supplied by the particular user, to match the alphanumeric information supplied by the particular user with alphanumeric information stored in a data repository, wherein the data repository relates types, versions and brands of consumer electronics equipment to their respective control codes (page 2, line 29 – page 3, line 4). From the dedicated server to the network connectable appliance, data representative of at least one control code is downloaded, wherein said data matches the alphanumeric information supplied by the particular user for use with the particular user's consumer electronics equipment. The particular user's remote control device is programmed according to the downloaded data representative of at least one control code, via the network connectable appliance (page 2, line 29 – page 3, line 4).

Further, the present invention, as recited in independent claim 7, is directed to a system that comprises a network connectable appliance configured to program a remote control device based on data received from a dedicated server, according to a user profile associated with the remote control device (page 3, lines 9 – 28). The remote control device for user-control of the network connectable appliance includes means for causing the network connectable appliance to initiate a connection to the dedicated server on the network (page 3, lines 9 – 28). The dedicated server configured to maintain a data repository comprises a plurality of user profiles. The dedicated server is further configured to request alphanumeric information from a particular user's network connectable appliance, corresponding to the particular user's consumer electronics equipment, responsive to said connection to the network connectable appliance (page 3, lines 9 – 28).

Still further, the present invention, as recited in independent claim 11, is directed to a method of creating a customer base comprising a plurality of user profiles (page 3, line 29 – page 4, line 8). The method comprises enabling respective users of consumer electronics equipment to specify, to a dedicated server on a data network, alphanumeric information about the respective users' consumer electronics equipment, wherein the users specify the information about the respective users' consumer electronics equipment via a query/answer session conducted between the user and the dedicated server via an intermediary network compatible device (page 3, line 29 – page 4, line 8). A plurality of respective user profiles is created for the customer base based on the user supplied alphanumeric information about the respective users' consumer electronics equipment conducted via said query/answer sessions (page 4, lines 9 - 28). The alphanumeric information is stored in the customer base (page 4, lines 9 - 28).

Still further, the present invention, as recited in independent claim 15, is directed to a method of providing a customized service to a user of consumer electronics equipment. At a dedicated server on a data network, alphanumeric information is received about the user's consumer electronics equipment (page 7, lines 9 – 29). A user profile is created based on the information. The user profile is used to enable the user to program, via the data network, a remote control device for controlling the user's consumer electronics equipment, wherein the server stores the information in a customer base comprising a plurality of user profiles, and each of the plurality of user profiles comprises at least one of (1) demographic information for an associated user and (2) data representative of a control code and/or UI for consumer electronics equipment information for an associated user (page 8, lines 10 – 30).

Still further, the present invention, as recited in independent claim 16, is directed to a method of enabling a user to control at least one consumer apparatus with a remote control device via a network connectable appliance (page 8, line 31 – page 9, line 12). The network connectable appliance is connected to a dedicated server on the network in response to the user controlling the remote control device, the dedicated server having an associated customer base comprising a plurality of user profiles, each of the plurality of user profiles identifying one or more consumer apparatuses for an associated user. From the dedicated server to the appliance, data representative of at least one control code is downloaded for control of at least one consumer apparatus via the network connectable appliance, according to a user profile associated with the remote control device (page 8, line 31 – page 9, line 12).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1) Whether claims 1-3 and 20-22 are properly rejected under 35 USC 103(a) as being obvious over U.S. Patent 5,410,326 (Goldstein) in view of U.S. Patent 6,477,573 (Lea).

2) Whether claims 7-12, 14-16, 19, 23 and 24 are properly rejected under 35 USC 103(a) as being obvious over Goldstein in view of Lea and further in view of U.S. Patent 6,314,572 (LaRocca).

3) Whether claim 25 is properly rejected under 35 USC 103(a) as being obvious over Goldstein in view of Lea and further in view of U.S. Patent 6,490,726 (Harrison).

VII. ARGUMENT

Appellant respectfully traverses the rejections in accordance with the detailed arguments set forth below. The rejection of Appellant's claims must be reversed in view of the arguments set forth below.

Claim 1 is directed to a method of programming a remote control device with data representative of a control code, which is downloaded from a dedicated server connected to a network, using a network connectable appliance as connecting means between the remote control device and the network. Appellant submits that the cited references, either individually or in combination, do not disclose or suggest all the limitations of the method claimed in claim 1 of the present application.

It is respectfully submitted that Goldstein does not teach "connecting a network connectable appliance to a dedicated server on the network" at Col. 4:11-26, as alleged in the Final Office Action. Goldstein only discloses "including a telephone interface, either as part of the cable television converter or as part of the customer's telephone system", which allows

placing a telephone call to a vendor or a service provider in response to an advertisement. Goldstein does not teach connecting an appliance to a dedicated server on the network, but merely providing an automated dialing interface for placing telephone calls.

It is also respectfully submitted that Goldstein does not teach "requesting, by the dedicated server via the network connectable appliance, alphanumeric information from the particular user, corresponding to the particular user's consumer electronics equipment, wherein said dedicated server request is made to said network connectable appliance" at Col. 15:41-44, as alleged in the Final Office Action. Goldstein discloses a transaction over the telephone between a user and a prerecorded message system: "Following verification of a caller ID 114, the prerecorded message requests the zip code 115 of the caller, and the equipment list 116..." At Col. 4:44-48, Goldstein discloses that the caller submits that information "via the touch pad on the telephone" not "via the network connectable appliance" connected to a "dedicated server on the network", as claimed in claim 1 of the present application.

In Goldstein, the communication between a customer and a data base occurs *after* "the customer or point-of-sales retailer initiates a telephone call with the data base via a modem/telephone interface" (Col. 15:32-34 of the patent), whereas claim 1 of the present application claims "connecting a network connectable appliance to a dedicated server on the network *in response to* the particular user controlling the particular user's remote control device."

The Final Office Action acknowledges that Goldstein does not teach step (d) of the method claimed in claim 1, i.e. Goldstein does not teach "performing a query, at the dedicated server, based on the alphanumeric information supplied by the particular user, to match the alphanumeric information supplied by the particular user with alphanumeric information stored

in a data repository, wherein the data repository relates types, versions and brands of consumer electronics equipment to their respective control codes.” The Examiner relies upon Lea for this step of the method. Appellant submits that this reliance is misplaced, since Lea does not disclose a data repository that relates types, versions and brands of consumer electronics to their respective control codes, and on which a query is performed based on alphanumeric information supplied by a particular user. Lea is directed to a system and method for performing a hierarchical remote query of a network in order to identify and pool software resources. The registry disclosed in Lea includes relevant information or attributes corresponding to the listed software elements. Lea’s registry allows a software element to obtain a software element identifier for identifying and locating another software element in a network (Col. 6:27-40): “In the FIG. 4 embodiment, registry 412 may preferably include a listing of software elements in network software 316.” Appellant, therefore, submits that Lea does not teach step (d) of the method of the present invention as claimed in claim 1.

Even if the “software elements” listed in Lea’s registry were construed as “control codes” as the Examiner apparently does in the Final Office Action, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine their teachings in order to obtain the method of claim 1 with all its steps and limitations. Lea does, in fact, teach away from “a method of enabling a particular user to program the particular user’s remote control device,” because it is directed to an automated method for updating a plurality of software elements that work together in a network of electronics devices. The present invention requires a user’s manual input, whereas Lea’s purpose is to implement a method for managing communications between various software elements in a way that does not require any input from a user.

Furthermore, Appellant submits that combining Goldstein with Lea would not yield the method of the present invention as claimed in claim 1, even if there were any suggestion to do so. Combining "a user accessing a remote server by telephone in order to download a programming code for a remote control device" with "a software element querying a registry to locate other software elements in a network" does not yield the method of claim 1, wherein "a dedicated server is connected to an appliance in response to a particular user controlling a remote control device, an exchange of information occurs between the dedicated server and the user, and a query is performed at the dedicated server, to match the information supplied by the user with information stored in a data repository."

It is stated in MPEP Section 2142:

"To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) *must teach or suggest all the claim limitations*." ... If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

As discussed above, the combination of Goldstein and Lea fails to teach every element of Appellant's claim 1. Appellant, therefore, respectfully submits the final rejection of claim 1 lacks factual and legal basis and should be reversed, per MPEP Section 2142. Claim 1 should be passed to issue.

Claims 2, 3 and 20 – 22 depend, either directly or indirectly, from independent claim 1 and thus incorporate novel and non-obvious features thereof, in addition to further limitations. Therefore, dependent claims 2, 3 and 20 – 22 are patentably distinguishable over the prior art of record for at least the same reasons as independent claims. Appellant, therefore, respectfully submits the final rejection of claims 2, 3 and 20 – 22 lacks factual and legal basis and should be reversed. Claims 2, 3 and 20 – 22 should be passed to issue.

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Claim 7 is directed to a system comprising, *inter alia*, a network connectable appliance configured to program a remote control device based on data received from a dedicated server, according to a user profile associated with the remote control device. This system is essentially configured to perform the method claimed in claim 1, and therefore Applicant incorporates herein by reference the arguments presented above in the response to the 103(a) rejections of claim 1 over Goldstein in view of Lea. Additionally, Applicant submits that combining LaRocca with Goldstein and Lea does neither anticipate nor suggest the system claimed in claim 7.

It is respectfully submitted that Goldstein does not teach that “**control codes** from said server are provided according to a user profile **associated with the remote control device.**” Goldstein actually discloses a remote control device including a touch screen display, which **displays icons representing the various services** for which the user has subscribed (Col. 3:45-51). In other words, in Goldstein the information displayed by the remote control device is related to services, whereas in the system of claim 7 the information provided by the server is associated with the apparatus itself, not with the various services provided.

Further, Goldstein does not teach a remote control device “including means for causing the network connectable appliance to initiate a connection to the dedicated server on the network.” Goldstein actually discloses “a telephone interface, either as part of the cable television converter, or as part of the customer’s telephone system, [that allows] to place a call to respond to an advertisement” and also “a command is sent to the telephone interface to establish a connection with the service provider.” In other words, Goldstein does not teach means for causing a connection between the appliance and a dedicated server, but merely an interface for automatic dialing of a phone number.

According to the Final Office Action, it is acknowledged that Goldstein does not teach “a data repository comprising a plurality of user profiles” as claimed in claim 7 and relies upon LaRocca for this particular limitation. Here again, the information contained in the user profiles of the present invention is related to the remote control device itself, whereas LaRocca discloses profiles that only contains customer subscription information pertaining to a customer’s type of service (Col. 5:29-40 of the LaRocca patent).

It is therefore submitted that claim 7 and dependent claims 8 and 9 are not obvious over the cited art references. Appellant, therefore, respectfully submits the final rejection of claims 7 – 9 lacks factual and legal basis and should be reversed, per MPEP Section 2142. Claims 7 – 9 should be passed to issue.

Independent claims 11, 15 and 16 were rejected by the Examiner using the same grounds of rejections as for claim 7, and the Examiner stated that the same rationale of rejection used for claims 1 and 7 is applicable to claims 11, 15 and 16. Consequently, Appellant incorporates herein by reference the arguments presented above in the responses to the 103(a) rejections of claims 1 and 7, and submits that claims 11, 15 and 16 are allowable over the cited art references at least for the same reasons that claims 1 and 7 are allowable.

It is therefore submitted that claims 11, 15 and 16 are not obvious over the cited art references. Appellant, therefore, respectfully submits the final rejection of claims 11, 15 and 16 lacks factual and legal basis and should be reversed, per MPEP Section 2142. Claims 11, 15 and 16 should be passed to issue.

It is submitted that claims 12 and 14 are also allowable because they ultimately depend from claim 11, which is allowable over the cited art references based upon the above arguments. Accordingly, reconsideration and withdrawal of their rejections is respectfully requested.

Claim 25 is dependent from claim 1, and thus incorporates novel and non-obvious features thereof, in addition to further limitations. Harrison is not relied upon in the Final Office Action to cure the deficiencies in Goldstein and Lea, as pointed out above with reference to claim 1. Claim 25 is, therefore, patentably distinguishable over the prior art of record. Appellant submits the final rejection of claim 25 lacks factual and legal basis and should be reversed. Claim 25 should be passed to issue.

VIII. CONCLUSION

In light of the above, Appellant respectfully submits that the rejection of claims 1-3, 7-12, 14-16 and 19-25 is in error. The prior art references, whether alone or in combination, relied upon in the Final Office Action do not render obvious Appellant's claims 1-3, 7-12, 14-16 and 19-25. Thus, Appellant respectfully submits that the obviousness rejection is in error, legally and factually, and must be reversed.

Respectfully submitted,

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for Yuri Kateshov, Reg. No. 34,466
914-723-6802

May 29, 2006

IX. CLAIMS APPENDIX

1. A method of enabling a particular user to program the particular user's remote control device for use with the particular user's consumer electronics equipment, the method comprising:

a) connecting a network connectable appliance to a dedicated server on the network in response to the particular user controlling the particular user's remote control device;

b) requesting, by the dedicated server via the network connectable appliance, alphanumeric information from the particular user, corresponding to the particular user's consumer electronics equipment, wherein said dedicated server request is made to said network connectable appliance responsive to said connection at said act (a);

c) supplying, from the particular user to the dedicated server, via the network connectable appliance, the requested alphanumeric information, corresponding to the particular user's consumer electronics equipment;

d) performing a query, at the dedicated server, based on the alphanumeric information supplied by the particular user, to match the alphanumeric information supplied by the particular user with alphanumeric information stored in a data repository, wherein the data repository relates types, versions and brands of consumer electronics equipment to their respective control codes;

e) downloading, from the dedicated server to the network connectable appliance, data representative of at least one control code, wherein said data matches the alphanumeric information supplied by the particular user for use with the particular user's consumer electronics equipment; and

f) programming the particular user's remote control device according to the downloaded data representative of at least one control code, via the network connectable appliance.

2. The method of claim 1, further comprising providing a menu to the particular user for customizing the programming of the particular user's remote control device in accordance with the downloaded data, prior to said act (e).

3. The method of claim 1, wherein said act (e) further comprises transmitting a wireless signal including the data representative of at least one control code from the network connectable appliance to the particular user's remote control device for the programming thereof.

4 - 6. (Cancelled)

7. A system, comprising:

a network connectable appliance configured to program a remote control device based on data received from a dedicated server, according to a user profile associated with the remote control device; and

the remote control device for user-control of the network connectable appliance including means for causing the network connectable appliance to initiate a connection to the dedicated server on the network;

the dedicated server configured to maintain a data repository comprising a plurality of user profiles;

the dedicated server being further configured to request alphanumeric information from a particular user's network connectable appliance, corresponding to the particular user's consumer electronics equipment, responsive to said connection to the network connectable appliance.

8. The system of claim 7, wherein the network connectable appliance includes means for allowing a user to customize the programming of the remote control device based on the data received from the server.
9. The system of claim 7, wherein the network connectable appliance transmits a wireless signal to the remote control device to program the remote control device.
10. The method of claim 1, wherein the network connectable appliance comprises a set top box.
11. A method of creating a customer base comprising a plurality of user profiles, the method comprising:
- enabling respective users of consumer electronics equipment to specify, to a dedicated server on a data network, alphanumeric information about the respective users' consumer electronics equipment, wherein the users specify the information about the respective users' consumer electronics equipment via a query/answer session conducted between the user and the dedicated server via an intermediary network compatible device;
 - creating a plurality of respective user profiles for the customer base based on the user supplied alphanumeric information about the respective users' consumer electronics equipment conducted via said query/answer sessions; and
 - storing the alphanumeric information in the customer base.
12. The method of claim 11, further comprising:

supplying targeted or customized advertisements or services to the respective users, via the respective network compatible devices thereby subsidizing the respective network compatible devices.

13. (Cancelled)

14. The method of claim 11, further comprising using the customer base to provide customized services to the respective users.

15. A method of providing a customized service to a user of consumer electronics equipment, the method comprising:

receiving, at a dedicated server on a data network, alphanumeric information about the user's consumer electronics equipment;

creating a user profile based on the information; and

using the user profile to enable the user to program, via the data network, a remote control device for controlling the user's consumer electronics equipment;

wherein the server stores the information in a customer base comprising a plurality of user profiles, and each of the plurality of user profiles comprises at least one of (1) demographic information for an associated user and (2) data representative of a control code and/or UI for consumer electronics equipment information for an associated user.

16. A method of enabling a user to control at least one consumer apparatus with a remote control device via a network connectable appliance, the method comprising:

connecting the network connectable appliance to a dedicated server on the network in response to the user controlling the remote control device, the dedicated server having an associated customer base comprising a plurality of user profiles, each of the plurality of user profiles identifying one or more consumer apparatuses for an associated user; and

downloading, from the dedicated server to the appliance, data representative of at least one control code for control of at least one consumer apparatus via the network connectable appliance, according to a user profile associated with the remote control device.

17 - 18. (Cancelled)

19. The method of claim 2, wherein the menu allows the particular user to specify whether certain operations provided by the downloaded data are desired.

20. The method of claim 2, wherein the menu allows the particular user to program a single action on the particular user's remote control device to cause the execution of multiple activities of the particular user's consumer electronics equipment.

21. The method of claim 1, further comprising providing a display with a graphical representation of the particular user's remote control device for use in the programming of the particular user's remote control device.

22. The method of claim 1, further comprising:
downloading, from the dedicated server to the Internet-connectable appliance, user interface data regarding the particular user's remote control device.
23. The method of claim 22, further comprising:
using the network connectable appliance for the programming of the particular user's remote control device according to the user interface data.
24. The method of claim 22, further comprising:
the user interface data provides information regarding features that support user interaction with the user's remote control device.
25. The method of claim 1, wherein the network is the Internet.

X. EVIDENCE APPENDIX

None.

XI. RELATED PROCEEDINGS APPENDIX

None.